

Appl. No. 09/940,283  
Amtd. Dated June 23, 2005  
Reply to Office Action of February 23, 2005

### **REMARKS**

The following remarks are submitted in response to the Office Action mailed February 23, 2005. Claims 1-13, 15-24, 26-46, 52-56, 58-85, 87-107, 113, 115-147, 149 and 150 are pending in the patent application. With this amendment, claims 25, 47-51, 86 and 108-112 have been cancelled, and claims 1, 26, 52, 87 and 133 have been amended. Claims 3, 60 and 116 remain withdrawn. Support for the amendments to the claims is found in the specification, claims, and drawings as originally filed. No new matter has been added. Reconsideration, reexamination and allowance of the pending claims are respectfully requested.

#### **Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 113, 115, 117-132, 134-147, 149 and 150 are allowed, and that claims 32-36, 93-97 and 133 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

#### **Claim Objection**

Claim 133 is objected to because it is dependent from claim 133. The claim has been amended to depend from claim 113.

#### **Withdrawn Claims**

Claims 3, 60, and 116 are currently withdrawn from consideration. Applicants respectfully request the Examiner consider these claims because they read on the elected species shown in FIGS. 23A and 23B.

#### **Rejection under 35 U.S.C. § 102(b)**

Claims 1, 2, 4, 16-18, 21, 23-25, 31, 39, 40, 50, 52, 55, 56, 59, 61, 64-69, 71, 75-80, 86, 92, 100 and 101 are rejected as being anticipated by Trabucco et al. (U.S. 5,243,977).

Independent claims 1 and 52 have been amended to recite an implantable cardioverter-defibrillator having an electrical circuit that provides cardioversion-defibrillation energy to the patient's heart. Trabucco et al. teach a pacemaker for stimulating the heart. Trabucco et al. do not teach or suggest their device as having an electrical circuit that provides cardioversion-

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defibrillation energy to the heart. Applicants submit that the terms "pacemaker" and "cardioverter-defibrillator" are understood by one of ordinary skill in the art to refer to distinct devices with structural and functional differences. In particular, one of ordinary skill in the art would understand that a cardioverter-defibrillator provides electrical impulses or shocks of a magnitude substantially greater than pulses used in cardiac pacing. Applicants submit that absent a specific teaching, one of ordinary skill in the art would not expect the pacemaker of Trabucco et al. to have an electrical circuit that provides cardioversion-defibrillation energy to the heart. Additionally, there is no motivation or suggestion for one of ordinary skill in the art to modify the pacemaker of Trabucco et al. to provide cardioversion-defibrillation energy to the heart. Trabucco et al. teaches their device as specifically designed and configured to be small and to be implanted in contact with the epicardium. See column 2, lines 35-45. Trabucco et al. thus do not teach or suggest the elements of independent claims 1 and 52, or the claims dependent thereon. Applicants submit that independent claims 1 and 52, and the claims depending therefrom, are now in condition for allowance. Withdrawal of the rejection is respectfully requested.

**Rejections under 35 U.S.C. § 103(a)**

Claims 5-13, 15, 19-22, 26-30, 37, 38, 41-46, 53, 54, 58, 62, 63, 70, 72-74, 81-85, 87-91, 98, 99 and 102-107 as obvious over Trabucco et al. alone or in combination with various references.

All of the claims so rejected depend either directly or indirectly from independent claims 1 and 52, and as stated above, independent claims 1 and 52 have been amended to include subject-matter that is not taught or suggested by Trabucco et al. As such, these claims are now believed to be in condition for allowance, and withdrawal of the rejections is respectfully requested.

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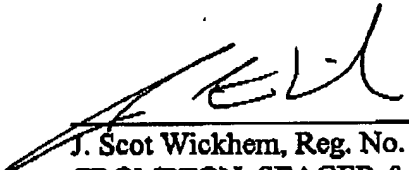
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Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,

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